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10/575,705	04/13/2006	Yuichi Futa	2006_0545A	2366

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LIM, SENG HENG

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/575,705	FUTA ET AL.
	Examiner	Art Unit	
	SENG H. LIM	3714	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>26 February 2008</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-4 and 6-16</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-4 and 6-16</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☒ All b) ☐ Some * c) ☐ None of:

        1. ☒ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public

use or on sale in this country, more than one year prior to the date of application for patent in the United

States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto

(EP0991007A1).

Miyamoto discloses a game system comprising a first game execution apparatus

and a second game execution apparatus that have different internal structure from each

other (Fig. 4), wherein the first game execution apparatus [0038]includes: a first

program reading unit operable to read, from a first game recording medium, a first game

program that indicates a procedure of a game [0020]; a first character reading unit

operable to read, from a portable recording medium, character data that indicates an

attribute of a character that appears in the game [0029]; a first input unit operable to

receive an inputting operation from a user; and a first game execution unit operable to

proceed with the game according to the inputting operation received at the first input

unit and the procedure indicated by the first game program, and to cause the character

appear in the game in accordance with the character data read by the first character

reading unit [0042], and the second game execution apparatus [0044] includes: a

second program reading unit operable to read, from a second game recording medium,

a second game program that indicates the procedure of the game [0021]; a second

character reading unit operable to read the character data from the portable recording

medium [0029]; a second input unit operable to receive an inputting operation from the

user; and a second game execution unit operable to proceed with the game according

to the inputting operation received at the second input unit and the procedure indicated

by the second game program, and to cause the character appear in the game in

accordance with the character data read by the second character reading unit [0048], wherein the character has plurality of attributes and to each of which a game execution apparatus is assigned for permitting a change of the attributes. The apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus (i.e. the permission information is the cartridge identification data or code), and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed (i.e. preventing changes to different cartridge identification data or code).

    <u>Claims 2, 4, 6-8, 15-16</u> are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).
    Miyamoto discloses a game execution apparatus comprising program reading unit operable to read, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading unit operable to read, from a portable recording medium, character data that indicates an attribute of a character that appears in the game [0029]; an input unit operable to receive an inputting operation from a user [0064]; and a game execution unit operable to proceed with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and to cause the character to appear in the game in accordance with character data read by the character reading unit [0048], wherein the character has plurality of attributes and to each of which a game execution apparatus is assigned for permitting a change of the attributes. The apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus (i.e. the permission information is the cartridge identification data or code), and in accordance with the read permission information, the game execution unit

change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed (i.e. preventing changes to different cartridge identification data or code) [0054-0055].

The apparatus includes a game recording medium wherein it permits change to the character's characteristics and prohibits the change of the character's characteristics according to permissible information based on a player-by-player basis in a manner discriminating one's data from others'. Each new captured character is stored or written into the portable recording medium or overwrites the pre-existing character data with the new one when the character changes [0054-0055].

The apparatus further includes a determining means for determining based on the data memory means if it is usable or not (i.e. authenticity). An inapplicable notifying means notifies inapplicability when not usable is determined by the use determining means [0022]. The character reading unit would inherently read the character data when the authenticity has been ensured.

Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Takeda et al (US 6,190,257 B1).

Takeda et al discloses an external storage unit comprising a storage unit (Fig. 16A: 76); the external storage unit authenticate the main unit peripheral interface (i.e. game apparatus) (31:29-31); and inherently an output unit operable to, when the authenticity as been ensured, read the data from the storage unit and output the data to the game apparatus, wherein the character has plurality of attributes and to each of which a game execution apparatus is assigned for permitting a change of the attributes. The storage unit stores therein permission information for each of a plurality of game execution apparatuses, the permission information indicating which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus (i.e. the permission information is the cartridge identification data or code) [0054-0055].

    <u>Claim 10</u> is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto
(EP0991007A1).

    Miyamoto discloses a game execution method comprising program reading step
of reading, from a game recording medium, a game program that indicates a procedure
of a game [0020]; reading, from a portable recording medium, character data that
indicates an attribute of a character that appears in the game [0029]; receiving an
inputting operation from a user [0064]; and proceeding with the game according to the
inputting operation received at the input unit and the procedure indicated by the game
program, and cause the character to appear in the game in accordance with the
character data read by the character reading unit [0048], wherein the character has
plurality of attributes and to each of which a game execution apparatus is assigned for
permitting a change of the attributes. The apparatus comprises a permission information
reading unit operable to read permission information that indicates which attribute from
the plurality of attributes is permitted to be changed by the assigned game execution
apparatus (i.e. the permission information is the cartridge identification data or code),
and in accordance with the read permission information, the game execution unit
change the attribute permitted to be changed by the game execution apparatus as the
game proceeds, and prohibit an attribute not permitted to be changed by the game
execution apparatus from being changed (i.e. preventing changes to different cartridge
identification data or code) [0054-0055].

    <u>Claim 11</u> is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto
(EP0991007A1).

    Miyamoto discloses a game execution program comprising reading, from a game
recording medium, a game program that indicates a procedure of a game [0020];
reading, from a portable recording medium, character data that indicates a
characteristic of a character that appears in the game [0029]; receiving an inputting
operation from a user [0064]; and proceeding with the game according to the inputting

operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048], wherein the character has plurality of attributes and to each of which a game execution apparatus is assigned for permitting a change of the attributes. The apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus (i.e. the permission information is the cartridge identification data or code), and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed (i.e. preventing changes to different cartridge identification data or code) [0054-0055].

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

Miyamoto discloses a computer-readable recording medium that stores a game execution program wherein the program has a game execution apparatus to execute reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; reading, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; receiving an inputting operation from a user [0064]; and proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048], wherein the character has plurality of attributes and to each of which a game execution apparatus is assigned for permitting a change of the attributes. The apparatus comprises a permission information reading unit operable to read permission information that indicates which attribute from the plurality of attributes is permitted to be changed by the assigned game execution apparatus (i.e. the

permission information is the cartridge identification data or code), and in accordance with the read permission information, the game execution unit change the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibit an attribute not permitted to be changed by the game execution apparatus from being changed (i.e. preventing changes to different cartridge identification data or code) [0054-0055].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

<u>Claim 3</u> is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (EP0991007A1).

Miyamoto teaches the basic claimed apparatus as set forth above in claim 2.

Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium, however,

the Office takes Official Notice that connecting a game apparatus to a network server to download the character data and writing to the portable recording medium is well known in the art. At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (EP0991007A1).

Miyamoto teaches the basic claimed program as set forth above in claim 11.

Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium, however, the Office takes Official Notice that connecting a game apparatus to a network server to download the character data and writing to the portable recording medium is well known in the art. At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

Response to Arguments

Applicant's arguments filed 2/26/2008 have been fully considered but they are not persuasive. Applicant argues that Miyamoto does not disclose " a permission information reading unit operable to read permission information that indicates with attribute from the plurality of attributes is permitted to be changed by the game execution apparatus... in accordance with the read permission information, changes the attribute permitted to be changed by the game execution apparatus as the game proceeds, and prohibits an attribute not permitted to be changed by the game execution apparatus from being changed." The Office disagrees because Miyamoto does disclose this. The permission information in Miyamoto is the cartridge identification data or code and when both the identification data are coincident with, the relevant-player's data in the RAM is read out and then written for update of the character's attributes [0055].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SENG H. LIM whose telephone number is (571)270-3301. The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. H. L./
Examiner, Art Unit 3714
May 7, 2008
/XUAN M. THAI/
Supervisory Patent Examiner, Art Unit 3714